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09/584,516	05/31/2000	David A. Grabelsky	00,011	1984
7590 12/29/2004				
McDONNELL BOEHNEN HULBERT & BERGHOFF 300 South Wacker Drive Chicago, IL 60606			EXAMINER HOM, SHICK C	
			ART UNIT 2666	PAPER NUMBER

DATE MAILED: 12/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/584,516

**Applicant(s)**

GRABELSKY ET AL.

**Examiner**

Shick C Hom

**Art Unit**

2666

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 31 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18, 21, 22, 24-27 and 33 is/are rejected.
- 7) ☒ Claim(s) 19-20, 23, 28-32 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

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## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments with respect to claims 1-32 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Objections***

2. Claims 1-32 are objected to because of the following informalities: In claim 1 lines 5-6, the words "a first network subdevice" seem to refer back to the "first network subdevice" recited in claim 1 line 4. If this is true, it is suggested changing "a first network subdevice" to ---the first network subdevice---. In claim 14 line 8, the words "a second network subdevice" seem to refer back to the "second network subdevice" recited in claim 14 line 5. If this is true, it is suggested changing "a second network subdevice" to ---the second network subdevice---. In claim 14 lines 9 and 11, the words "a second network address" seem to refer back to the "second network address" recited in claim 14 lines 5-6. If this is true, it is suggested changing "a second network address" to ---the second network address---. In claim 14 line 10, the words "a first network address" seem to refer back to the "first network

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address" recited in claim 14 line 4. If this is true, it is suggested changing "a first network address" to ---the first network address---. In claim 14 line 12, the words "a plurality of network devices" seem to refer back to the "plurality of network devices" recited in claim 14 lines 6-7. If this is true, it is suggested changing "a plurality of network devices" to ---the plurality of network devices---. In claim 14 line 12, the words "a second network" seem to refer back to the "second network" recited in claim 14 line 7. If this is true, it is suggested changing "a second network" to ---the second network---. Claims 2-13 and 15-32 are objected to because depend from objected claims 1 and 14, respectively. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

3. Claims 1-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1 lines 9-10 which recite "the second network device" lacks clear antecedent basis because no second network device have been previously recited in the claim and therefore the limitation is not clearly understood; further it is not

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clear as to whether it is reciting ---the second network subdevice--- as in claim 1 line 5. Claims 2-13 are rejected under 35 U.S.C. 112, second paragraph because they depend from rejected claim 1.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary.

Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35

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U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 14-18, 21-22, and 24-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martin et al. (6,624,788) in view of Sridhar et al. (6,098,108).

Regarding claim 14:

Martin et al. disclose the network access device, comprising in combination: (a) a first network; (b) a first network subdevice comprising a network client on the first network, wherein the first network subdevice has a first network address for communicating with other network subdevices and requests from a second network subdevice allocation of a second network address for communicating with a plurality of network devices on a second network (see col. 4 lines 30-47 which recite the network client, the LAN, and the WAN which corresponds to the first and second network); and (c) a second network subdevice on the first network comprising a network address server for allocating a second network address to the first network subdevice, wherein the second network subdevice has a first network address for communicating with other network subdevices on the first network and a second network address for communicating with a plurality of network devices on a second network, and wherein the network address server is used to

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allocate the second network address to the first network subdevice on the first network (see col. 2 lines 5-13 which recite the server for allocating the network address to the client which requests the allocation of the network address clearly anticipate the network address server).

Regarding claims 15, 17, 24, and 26-27:

Martin et al. disclose wherein the first network is a private Internet Protocol network; wherein the first network address of the first network subdevice is a private network address; wherein the private network address of the second network subdevice is an Internet protocol address; wherein the public network address of the second network subdevice is an Internet protocol address; and wherein the second network is any of the Internet or an intranet (see col. 1 lines 24-32 and col. 2 lines 14-30 which recite management of IP addresses for the user or client on a LAN).

Regarding claim 16:

Martin et al. disclose wherein the second network is a public network (see col. 4 lines 30-46 which recite the WAN).

Regarding claim 18:

Martin et al. disclose wherein the first network address of the second network subdevice is a private network address and the second network address of the second network subdevice is a

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public network address (see col. 1 lines 24-32 and col. 2 lines 14-30 which recite management of IP addresses for the user or client on a LAN and col. 4 lines 30-46 which recite the WAN).

Regarding claims 21-22:

Martin et al. disclose wherein the first network subdevice is a communications card and wherein the communications card is a modem card (see col. 4 lines 30-46 and col. 4 line 60 to col. 5 line 5 which recite the modems).

Regarding claim 25:

Martin et al. disclose wherein the second network subdevice is a router subsystem (see col. 4 lines 30-46 which recite the router connecting the LAN to the WAN).

For claims 14-18, 21-22, and 24-27, Martin et al. disclose all the subject matter of the claimed invention with the exception of the one or more ports for communicating with a plurality of network devices as recited in claim 14.

Sridhar et al. from the same or similar fields of endeavor teach that it is known to provide the one or more ports for communicating with a plurality of network devices as recited in claim 14 (see col. 11 lines 20-39 which recite that it is typical to provide the address and port for setting up a path). Thus, it would have been obvious to the person having ordinary skill in the art at the time the invention was made to provide

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the one or more ports for communicating with a plurality of network devices as taught by Sridhar et al. in the network access device of Martin et al. The one or more ports for communicating with a plurality of network devices of Sridhar et al. can be implemented by associating the ports with the allocated addresses of Martin et al. The motivation for using the one or more ports for communicating with a plurality of network devices as taught by Sridhar et al. in the network access device of Martin et al. being that it provides more efficiency for the system since the specific port have already been provided for the connection once the address is found and provided to the first network subdevice.

7. Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Martin et al. (6,614,788) and Sridhar et al. (6,098,108) in view of McHale et al. (6,160,840).

Regarding claim 33:

For claim 33, Martin et al. and Sridhar et al. disclose the network access device described in paragraph 6 of this office action.

For claim 33, Martin et al. and Sridhar et al. disclose all the subject matter of the claimed invention with the exception of wherein the first private network subdevice and the second

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private network subdevice are cards in a rack having a common backplane.

McHale et al. from the same or similar fields of endeavor teach that it is known to provide the first private network subdevice and the second private network subdevice being cards in a rack having a common backplane (see col. 4 lines 1-16 which recite the components of the mainframe device, mini-frame device, and computer using the PCI bus). Thus, it would have been obvious to the person having ordinary skill in the art at the time the invention was made to provide the first private network subdevice and the second private network subdevice being cards in a rack having a common backplane as taught by McHale et al. in the network access device of Martin et al. and Sridhar et al. The first private network subdevice and the second private network subdevice being cards in a rack having a common backplane can be implemented by providing the cards in a rack having a common backplane of McHale et al. as means for housing the logics and wiring of the device of Martin et al. and Sridhar et al. The motivation for using cards in a rack having a common backplane as taught by McHale et al. in the device of Martin et al. and Sridhar et al. being that it provides more cost effective design for the device since the device uses standard housing and wiring for the logic components.

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***Allowable Subject Matter***

8. Claims 1-13 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

9. Claims 19-20, 23, and 28-32 would be allowable if rewritten to overcome the objections set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Wang et al. disclose method and apparatuses for transferring data for multiple applications through a single communication link in response to authentication information.

Applegate et al. disclose system and method for redirecting network traffic to provide secure communication.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shick C Hom whose telephone number is 571-272-3173. The examiner can


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normally be reached on Monday to Friday with alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Seema Rao can be reached on 7571-272-3174. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SH

  
**FRANK DUONG**  
**PRIMARY EXAMINER**